



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,112	11/03/2000	Jerome Swartz	04873-031003	5868

26161 7590 02/04/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,112

Applicant(s)

SWARTZ, JEROME

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13, 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the IDS filed on 2/25/2002, the extension of time and notice of appeal filed on 8/15/2002, the IDS filed on 12/19/2002, the extension of time, RCE, and amendment filed on 12/16/2002, all of which have been entered in the file. Claims 20-25 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/16/2002 has been entered.

Claim Rejections - 35 USC § 103

2. Claims 20, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi, deceased (US 5,057,943, cited by applicant) in view of Christopher et al (US 5,227,617, cited by applicant).

Re claims 20 and 23-25: Takahashi teaches an apparatus for writing optical indicia on a medium 1. The apparatus includes: a central processing unit (CPU) (A/0 controller 6) for controlling the apparatus, a light source (laser 2) for generating a light beam (laser beam) suited for writing the optical indicia on the medium, a scanning element (A/0 modulator 5 and polygon mirror 70) under control of the CPU that directs the light beam at the medium in a pattern prescribed by the CPU, the light beam (laser

Art Unit: 2876

beam) is pulsed by the A/O modulator 5 (see figures 1, 4, column 1 lines 6-12, column 2 lines 43-66, and column 3 line 22 - column 4 line 9).

Takahashi fails to teach a housing configured to be hand held, and an interface for connecting the apparatus to external devices.

Christopher et al teaches a hand held apparatus 10 for writing optical indicia on a medium. The apparatus includes: a housing (handle 20 and housing 22) configured to be hand held, and an interface 122 for connecting the apparatus to external devices (see figures 1, 2, 4, column 3 line 60 - column 4 line 29, column 5 lines 51-57, and column 6 lines 49-54).

In view of Christopher et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate, with the apparatus as taught by Takahashi, a housing configured to be hand held, and an interface for connecting the apparatus to external devices, in order to provide a portable hand held apparatus which can be easily carried to a desired location of use, thereby increasing the versatility of the apparatus, and in order to provide the ability to communicate with an external device, such as a host computer, thereby increasing the data storage/processing capabilities of the apparatus.

Re claim 21: Takahashi as modified by Christopher et al fails to specifically teach the optical indicia being alphanumeric characters.

However, Official Notice is taken that at the time of the invention it was well known to those of ordinary skill in the art to write optical indicia comprising alphanumeric characters on a medium.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate, with the apparatus as taught by Takahashi as modified by Christopher et al, the optical indicia including alphanumeric characters, in order to provide human readable indicia on the medium, which would simplify organization/record keeping, since the medium would not require machine reading to be identified.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi as modified by Christopher as applied to claim 20 above, and further in view of Miyagawa (US 5,488,489, cited by applicant).

Takahashi also teaches the medium 1 being photosensitive (see column 3, lines 31-34).

Takahashi as modified by Christopher et al fails to teach the medium being thermal sensitive.

Miyagawa teaches that a thermal sensitive medium is an art recognized functional equivalent of a photosensitive medium (see column 8, lines 24-28).

In view of Miyagawa's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the photosensitive medium, as taught by Takahashi as modified by Christopher et al, with a thermal sensitive medium, since they are art recognized functional equivalents.

Response to Arguments

4. Applicant's arguments filed 12/16/2002 have been fully considered but they are not persuasive.

In response to applicant's argument that none of the improvements in accuracy as taught in Takahashi could possibly be implemented were the scanner to be completely disconnected from the recording paper and simply held by hand over the paper, no one reading Takahashi would ever consider modifying Takahashi to make it a handheld apparatus as called for in claim 20 (see page 2, fourth and fifth paragraphs, of the amendment filed on 12/16/2002), it is noted that claim 20 merely recites "A hand-held apparatus ...", and, "a housing configured to be hand held;" (see lines 1-3). Claim 20 does not recite that the scanner is completely disconnected from the recording paper, and simply held by hand over the paper. Furthermore, the combination of Takahashi and Christopher, as recited in the office action, never proposed completely disconnecting the recording paper from the apparatus or the apparatus being simply held by hand over the recording paper. Rather, Takahashi and Christopher both teach the recording paper being in contact with the apparatus (see figure 1 of Takahashi and figure 2 of Christopher). Thus, when combining the teachings of Christopher with the teachings of Takahashi, one of ordinary skill in the art at the time of the invention would make the entire apparatus as taught by Takahashi hand held. There is no suggestion to completely disconnect the scanner/apparatus from the recording paper, as is being argued by applicants. Thus, applicants have not presented any compelling reason as to why the entire apparatus as taught by Takahashi would not be made hand-held, or why the apparatus as taught by Takahashi could not function as intended as a hand-held apparatus.

In response to applicant's argument that the combination suggested by the examiner of Takahashi with Christopher would simply never be even considered by the person of ordinary skill (see page 2, sixth paragraph, of the amendment filed on 12/16/2002), as discussed above, the combination suggested by the examiner never proposed completely disconnecting the recording paper from the apparatus or the apparatus being simply held by hand over the recording paper. Christopher teaches that the entire apparatus can be made hand-held and still retain the feature of the recording paper being in contact with the apparatus.

In response to applicant's arguments against the references individually (Christopher teaches away from using a hand held scanning beam to write indicia, Christopher uses a scanning beam only for reading indicia, writing is done using a thermal printhead, see page 3, first paragraph, of the amendment filed on 12/16/2002), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Christopher is merely being used to teach a housing configured to be hand-held, and an interface for connecting the apparatus to external devices. Takahashi teaches using a scanning beam to write indicia. Furthermore, Christopher teaches that printheads other than a thermal printhead may be used (see column 4, lines 41-43, of Christopher). Thus, there certainly is no requirement that the printhead must be a thermal printhead in order for the apparatus to be configured as a hand-held apparatus. Clearly the advantage of portability, derived from a housing configured to be hand-held,

was well within the knowledge generally available to one of ordinary skill in the art. The advantage of portability does not only apply to apparatuses using a thermal printhead, and encompasses other means for printing, as suggested by Christopher.

In response to applicant's argument that the examiners indication that Takahashi is silent as to whether the scanner is handheld is not accurate, everything taught in Takahashi assumes a mechanical connection between the scanning beam and the paper on which the beam is writing (see page 3, second paragraph, of the amendment filed on 12/16/2002), as discussed above, the combination of Christopher with Takahashi teaches making the entire device of Takahashi handheld. Since Christopher teaches a hand-held apparatus that maintains a mechanical connection between the apparatus and the recording paper, applicants have presented no evidence that Takahashi could not be made hand-held while maintaining the mechanical connection between the scanning beam and the recording paper.

Furthermore, applicants are reminded, the fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. See *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952). Applicants have not shown that using a housing configured to be hand-held produces any unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703)

Application/Control Number: 09/706,112
Art Unit: 2876

Page 8

305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-F, first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Jared J. Fureman
February 3, 2003